

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JONATHAN R. MERRIL

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Application 09/955,939

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on March 13, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on September 7, 2006. In response, an Examiner's Answer was mailed on December 13, 2006.

An Amendment cancelling claims 24 and 25 was filed on September 7, 2006. Section 1206 of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 3, August 2005) states that “[e]xaminers must respond to all amendments filed after appeal has been taken and prior to termination of the appeal.” The record is unclear as to whether this amendment has been considered.

In addition, the “Status of Claims” appearing in the Appeal Brief filed September 7, 2006 states:

Claims 1-23 are pending in this application and stand finally rejected. Claims 24 and 25 have been cancelled without prejudice to or disclaimer of the subject matter recited therein. The rejection of claims 1-23 is being appealed [page 2].

The Examiner’s Answer mailed December 13, 2006 agrees with the above statement by stating that [t]he statement of the status of claims contained in the brief is correct. Clarification is required because the examiner includes claims 24 and 25 in the 103(a) rejections appearing on pages 9 and 13 of the Answer.

Finally, while the “Related Appeals and Interferences” section of the Answer states that “[t]he examiner is unaware of any related appeals,

interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal" [page 3], the present application is a continuation-in-part of Application Serial No. 09/073,871. According to PALM, Serial No. 09/073,871 was given Appeal No. 2003-1858 and a Board of Patent Appeals and Interferences decision was rendered on March 12, 2004. Clarification is required.

Accordingly, it is

ORDERED that the application is returned to the examiner:

- 1) for consideration of the Amendment filed September 7, 2006;
- 2) for clarification regarding the status of claims 24 and 25;
- 3) for clarification regarding the "Related Appeals and Interferences" section; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: Patrick J. Nolan

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